

Application of Joseph Tesler
Serial No. 09/829,619 filed 4-10-2001
Response of 10-12-06 to Office Action of 4-12-06

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Remarks

Receipt is acknowledged of the Office Action dated April 12, 2006. A three month extension of the time provided for response and reconsideration of the application are respectfully requested. The Commissioner is hereby authorized to charge all fees due to Deposit Account No. 50-1604.

In the present response, applicant has added new claims 34-40 as set forth above. Applicant respectfully maintains the same response to the prior Office Actions as if fully set forth herein, and supplements the prior responses with the following additional comments.

It is well accepted that obviousness or non-obviousness is determined by looking at the scope and content of the prior art, and at the differences between the claims and the prior art from the perspective of one of ordinary skill in that art. See, *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The relevant art here is the art of preparing a Jewish religious scroll, the only art to which these claims pertain. It is against this background that the claims must be analyzed and evaluated.

It is also well accepted that 'secondary considerations', such as long felt but unsolved needs, are also relevant to the obviousness determination. *Id.* In fact, under Federal Circuit precedent, those long felt but unsolved needs must be considered. See e.g., *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983) (evidence of secondary considerations must be considered and may be the most probative evidence in the record).

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A central element of all of the claims here is that they are directed to 'Jewish religious scrolls'. Preparation of such scrolls is a long laborious process, and there has long been a need for a more rapid and efficient method of creating them. To counsel's knowledge, no one has previously provided such a method over many centuries.

In response, in the Office Action, the Examiner has stated that "[t]here are most likely thousands if not millions of particular textual documents that have not been silkscreened but would still have been obvious to silkscreen." *See*, Office Action of April 12, 2006 at page 9. This impermissibly disregards the unique issues involved with this particular art, and the evidence of long felt need in that art.

It is respectfully pointed out that reference to other textual documents – which do not share the requirements, restrictions, or circumstances surrounding Jewish religious scrolls – is fundamentally in error. Those other "texts" are not relevant to the invention, nor are they relevant to the extensive concerns of those making these religious articles. To analogize a Jewish religious scroll to just any "textual document" is tantamount to saying that U.S. government currency and words written on a napkin are also no different, and are both just "documents". Yet, the requirements and circumstances governing the preparation of a dollar bill and those surrounding a napkin sketch are not comparable in the least. So, too, there are complex religious laws surrounding these scrolls of the art in question which are not applicable to other texts.

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What is at issue is not whether it would be obvious to silkscreen a “textual document” but whether it would be obvious to use the recited methods to create a Jewish religious scroll. Such a scroll is an express element of the claim, as the claim is not directed to just “any document”.

For example, a Jewish religious scroll fundamentally requires a certain level of sanctity in its preparation, otherwise it is “unkosher” (invalid for ritual use). Other random “textual documents” do not share this characteristic requirement. A method for printing a textbook, for example, does not have to be designed to comport with the requirements of Jewish religious law that are associated with something very sacred. This yet again demonstrates the difference between Jewish religious scrolls and regular texts.

Thus, it is not merely happenstance that these scrolls have not previously been produced by automated means. The scrolls are governed by ancient, established, and venerated rules and customs. This cannot be overemphasized. Applicant maintains that his invention is a significant and permissible improvement upon those practices, and while there are numerous detractors who dispute the permissibility of that improvement within the ancient laws, it cannot be fairly disputed that it is a major innovation in applicant’s art. Indeed, the detraction only further demonstrates the nonobvious nature of his invention.

In connection with claims 34-35, the claims are directed to a new use. Irrespective of the Office Actions’ position regarding the “document”, the method of those claims further recites preparation of such a scroll for use in Jewish prayer services. (Claims 2-5 and 37-40 likewise recite

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the use of such scrolls as a Torah, Megillah, Mezzuzah or Tefilin). It is submitted that there is no evidence that any of these particular uses are obvious, and it is unlikely there is any such evidence other than impermissible hindsight. Again, Jewish religious scrolls require a level of sanctity for religious use that is a separate requirement wholly apart from merely placing text on a page.

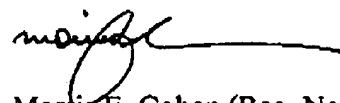
Similarly, in connection with claim 21, a method is recited wherein the scroll is prepared using two screens, a first screen of the text of the scroll without any of the names of G-d thereon, and a second screen with the names of G-d thereon. The first screen is provided with spaces where the names of G-d are located on the second screen, and the second screen is provided with spaces where the text of the scroll is located on the first screen. This also is not taught or suggested by the art in any manner, nor is it at all obvious.

Counsel again respectfully requests that if the Examiner is considering any further rejections, that he be contacted before such a rejection so that an interview can be arranged to discuss the claims for the purpose of arriving at allowable subject matter before another appeal is filed.

Favorable action on all of the claims is respectfully requested and believed fully warranted.

Dated: October 12, 2006

Respectfully submitted,



Morris E. Cohen (Reg. No. 39,947)
1122 Coney Island Avenue, Suite 217
Brooklyn, New York 11230
(718) 859-8009 (telephone)
(718) 859-3044 (facsimile)